

Appl. No. 09/444,359
Amdt. dated May 18, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

Claims 1-42 are pending in this application. Claims 1, 3, 4, 5, 17, 19, 21, 37, and 42 have been amended. Claims 2 and 18 have been cancelled. No claims have been added. Hence, claims 1, 3-17, and 19-42 are pending following entry of the amendments. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-26, 30-34, 37-39 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,230,017 to Andersson, et al. (hereinafter "Andersson"), and in view of the cited portions of U.S. Patent No. 6,577,857 to Rodriguez, et al. (hereinafter "Rodriguez").

Claims 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,397,040 to Titmuss, et al. (hereinafter "Titmuss").

Claims 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,522,888 to Garceran, et al. (hereinafter "Garceran").

Claims 35-36 and 40-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,212,377 to Dufour, et al. (hereinafter "Dufour").

Claims 1 and 17 have been amended to more particularly recite the Applicants' claimed invention. Claim 1 has been amended to include subject matter from cancelled claims 2 and to clarify that the wireless network receives the user defined, location dependent rules. Claim 17 has been amended to include subject matter from cancelled claim 18. Claims 3, 4, 5, 19, 21, 37, and 42 have been amended to correct dependency references. No new matter has been added by these amendments. Further, since the amendments generally incorporate subject matter from previous claims, the amendments should not raise new issues that require additional searching.

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Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims since the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations.

With respect to the third prong of the test and the rejection of claim 1 (which now includes subject matter from claim 2) the office action states that the limitation relating to the rule including “a specification for at least one geographic area associated with the mobile subscriber” may be found at col. 11, ll. 39-67 of Rodriguez. For a number of reasons, the teachings of this location do not read on the Applicants’ claims. First, the “Toll Restrictor Codes” described in the cited passage reside in the mobile unit (“The portable communication unit of the present invention also includes several parameters which are not found in conventional units, including ... a set of Toll Restrictor Codes.” Col. 10, line 66 – Col. 11, line 3). Thus, the codes are not “at the wireless network, receiv[ed] from the mobile subscriber.” The Toll Restrictor Codes are part of the portable communication unit.

Second, Rodriguez does not teach that the Toll Restrictor Codes are not “user-defined.” (“In particular, the ... Toll Restrictor Codes will typically be set by the dealer, and *preferably can only be changed when the unit is given back to the dealer.*” Col. 12, ll. 16-19, emphasis added) Thus, not only are the Toll Restrictor Codes not received at the wireless network, but the codes are not “user-defined.” Further, as is evident from the quoted citation, Rodriguez teaches away from user-defined rules since the Toll Restrictor Codes preferably can be changed only by the dealer.

Further still, the cited portion of Rodriguez relating to the limitation “rules for processing the at least one telephone service for the mobile subscriber when the mobile

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subscriber is in one of the geographic areas" includes that "an important feature of the invention is that *the portable communication unit may be provided with an access restriction profile, which limits the area for which long distance and even local calls may be placed*" (col. 7, ll. 27-42, emphasis added). Here again, in contrast to the Applicants' claimed invention, the "rules for processing the at least one telephone service for the mobile subscriber when the mobile subscriber is in one of the geographic areas" are not "user-defined." Thus, for the foregoing reasons, the office action has not satisfied the third prong of the test for *prima facie* obviousness since the prior art does not teach all the claim limitations and in fact teaches away from the Applicants' claimed invention. Claim 1 is, therefore, believed to be allowable.

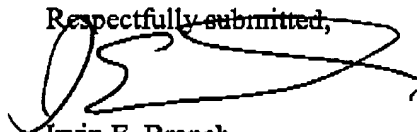
Claim 17 includes similar limitations and is believed to be allowable for similar reasons as are the remaining claims which depend from either claim 1 or claim 17.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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